

AMENDMENT

IN THE SPECIFICATION:

Please delete the last sentence of the paragraph added to page 1 by the Preliminary Amendment of April 7, 1998.

IN THE CLAIMS:

Please cancel claims 14-16, without prejudice of Applicants right to re-present of file these claims or claims of comparable scope in another proceeding and/or patent application(s).

REMARKS

Applicants have amended page 1 of the Specification as suggested by the Examiner. This sentence is, indeed, redundant, as the claim of priority to these particular parent applications was already stated earlier in the same paragraph. Applicants appreciate the Examiner's careful attention to the instant Application.

Applicants also acknowledge the Examiner's determination that the earliest filed parent application which discloses the production of a fusion protein by a viral vector is Serial No. 07/310,881, filed February 17, 1989 (more than four years before the PCT priority date of Patent No. 5,618,699 to Hamamoto *et al.*; hereinafter "the '699 Hamamoto Patent"). Pending claim 17 of the instant Application (corresponding to claim 16 of the '699 Hamamoto Patent) recites such a fusion protein. Accordingly, this single claim is sufficient to warrant the declaration of an Interference by the Examiner between the instant Application and the '699 Hamamoto Patent. During the November 4, 1998 Interview, the Examiner agreed that claim 17 of the instant Application was entitled to an effective filing date of

February 17, 1989, "...thus warranting interference." See, Interview Summary, Paper No. 7.

Accordingly, Applicants respectfully request that the Examiner declare an Interference between the subject Application and the '699 Hamamoto Patent.

As for the Examiner's allegation that "[n]one of the prior applications referred to by the amendment to the specification of 07 April 1998, other than the most recent parent application Serial No. 08/324,003, disclose the use of leaky stop codons for the production of fusion proteins by a viral vector...", Applicants respectfully disagree and traverse. However, in the interests of expediting prosecution of the instant Application, and pursuant to what was agreed upon between the Examiner and Applicants' representatives at the November 4, 1998 Interview, Applicants have cancelled claims 14-16 (corresponding to claims 1, 9 and 13, respectively, of the '699 Hamamoto Patent) without prejudice of Applicants' rights to re-present or file these claims or claims of comparable scope in another proceeding and/or patent application(s), and Applicants expressly reserve the right to defer this issue to the Preliminary Motion stage of the Interference proceedings and/or to file the same or similar claims in one or more continuing applications. However, for the purposes of the Examiner's outstanding § 102(e) rejection of those claims drawn to fusion proteins comprising a read-through sequence, Applicants submit that the cancellation of claims 14-16 hereby obviate this rejection, and Applicants request that it be withdrawn.

The Examiner has also rejected claims 14-17 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 5 of copending Application No. 08/324,003. In the interests of expediting prosecution of the instant Application, Applicants hereby express their willingness to file a properly executed Terminal Disclaimer at the time patentable subject matter is determined.

Appln. Serial No. 09/057,016
Attorney Docket No. 08010087US01

CONCLUSION

Claim 17 of the instant Application, which is identical to claim 16 of U.S. Patent No. 5,618,699 to Hamamoto *et al.*, has been determined by the Examiner to be entitled to the effective filing date of February 17, 1989. Accordingly, Applicants request that an Interference between the instant Application and U.S. Patent No. 5,618,699 be declared.

Respectfully submitted,

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Albert P. Halluin Reg. No. 25,227

HOWREY & SIMON
1299 Pennsylvania Avenue, N.W.
Box 34
Washington, D. C. 20004-2402
Tel: (650) 463-8100
Fax: (650) 463-8400